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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/081,357 | 02/22/2002 | Douglas H. Wylie | D1841-00079 | 9759 |

8933 7590 03/23/2004

DUANE MORRIS, LLP
IP DEPARTMENT
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EXAMINER

FISCHER, JUSTIN R

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1733

DATE MAILED: 03/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|------------------------------|--|
| Office Action Summary | Application No. 10/081,357 | Applicant(s) WYLIE ET AL. | |
| | Examiner Justin R Fischer | Art Unit 1733 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-50 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-8, drawn to a method for securing a ventilation cloth to a screen frame classified in class 156, subclass 160.
 - II. Claims 9-13, drawn to a method of securing a ventilation cloth to a screen bar segment, classified in class 156, subclass 160.
 - III. Claims 14-35, drawn to a ventilation cloth apparatus , classified in class 156, subclass 379.8.
 - IV. Claims 36-38, drawn to a cart for transporting a frame, classified in class 280, subclass 47.17.
 - V. Claims 39-50, drawn to a method for forming a screen/frame assembly, classified in class 156, subclass 160.
2. Inventions I and II are related as distinct inventions, each having a unique and separate means for establishing patentability. Invention I discloses a method for securing a cloth to a frame comprising orienting said frame, hanging a cloth, providing adhesive, and inserting said cloth in the adhesive. Invention II, on the other hand, requires a method for securing a cloth to a frame segment comprising providing a segment, spreading the cloth, melting the adhesive, and inserting said cloth in the adhesive. It is evident that Invention I does not require a melting step, wherein a different type of adhesive (e.g. pressure sensitive) could have been used and Invention II does not require the screen frame be oriented in a vertical position. As such, the

respective methods in each of the inventions are materially different and distinct and restriction is proper.

3. Inventions I and III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the method of Invention I can be done by hand (orienting of screen and inserting of ventilation cloth can be performed by hand as opposed to a "fixture" and "insertion device", respectively).

4. Inventions I and IV are related as distinct inventions, each having a unique and separate means for establishing patentability. Invention I is directed to a method of securing a ventilation cloth to a screen frame, whereas Invention IV is directed to a cart for transporting a frame. In this instance, Invention I does not require any of the particulars of the cart outlined by Invention IV- in fact, the method of Invention I does not even require a transporting step. Also, Invention IV does not require the particular method of Invention I (the cart of invention IV is generic to the transporting of any assembly formed by any method). As such, the respective inventions are materially different and distinct and restriction is proper.

5. Inventions I and V are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP §

Art Unit: 1733

806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because Invention I does not require a preheated adhesive or a plurality of pins. The subcombination has separate utility such as in a method in which the screen is not oriented in a vertical position.

6. Inventions II and III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the method of Invention II can be done by hand (inserting of ventilation cloth can be performed by hand as opposed to a "insertion device").

7. Inventions II and IV are related as distinct inventions, each having a unique and separate means for establishing patentability. Invention II is directed to a method of securing a ventilation cloth to a screen frame, whereas Invention IV is directed to a cart for transporting a frame. In this instance, Invention II does not require any of the particulars of the cart outlined by Invention IV- in fact, the method of Invention II does not even require a transporting step. Also, Invention IV does not require the particular method of Invention II (the cart of invention IV is generic to the transporting of any assembly formed by any method). As such, the respective inventions are materially different and distinct and restriction is proper.

8. Inventions II and V are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and

(2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because Invention II does not require a preheated adhesive or a plurality of pins. The subcombination has separate utility such as in a method in which a melting step is not required (e.g. pressure sensitive adhesive in which pre-heating step does not result in melting).

9. Inventions III and IV are related as distinct inventions, each having a unique and separate means for establishing patentability. Invention III discloses a ventilation cloth apparatus for securing a cloth to a frame, whereas Invention IV is directed to a cart for transporting a frame. In this instance, the apparatus of Invention III comprises only a fixture for orienting a screen frame and an insertion device for inserting said cloth in the adhesive- the apparatus fails to require a cart for transporting the frame. Also, Invention IV is solely directed to a cart for transporting a frame- there is no description of any apparatus used to secure the cloth to the frame. As such, the respective inventions are materially different and distinct and restriction is proper.

10. Inventions III and V are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this instance, the apparatus can be used to practice another and materially different process, for example one in which the adhesive is not pre-heated.

Art Unit: 1733

11. Inventions IV and V are related as distinct inventions, each having a unique and separate means for establishing patentability. Invention V is directed to a method of securing a ventilation cloth to a screen frame, including a pre-heating step, whereas Invention IV is directed to a cart for transporting a frame. In this instance, Invention V does not require any of the particulars of the cart outlined by Invention IV- in fact, the method of Invention V does not even require a transporting step. Also, Invention IV does not require the particular method of Invention V (the cart of invention IV is generic to the transporting of any assembly formed by any method). As such, the respective inventions are materially different and distinct and restriction is proper.

12. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

13. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

14. A telephone call was made to Steven Koffs on March 17, 2004 to request an oral election to the above restriction requirement, but did not result in an election being made.

Conclusion

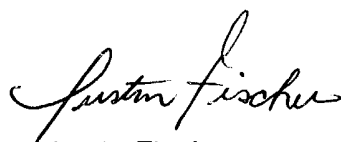
15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Justin R Fischer** whose telephone number is **(571) 272-1215**. The examiner can normally be reached on M-F (7:30-4:00).

Application/Control Number: 10/081,357
Art Unit: 1733

Page 7

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Justin Fischer

March 17, 2004



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